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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/813,852	03/07/97	DUCKERY R	21651.3

PM11/0607

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EXAMINER	
BARTUSKA,F	
ART UNIT	PAPER NUMBER
3652	19

DATE MAILED: 06/06/00

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

S.K.

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/813,852	03/07/97	DOCKERY R	21651.3

PM82/0606

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EXAMINER	
BARTUSKA, F	
ART UNIT	**PAPER NUMBER**
3652	19

DATE MAILED: 06/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/813852	R.L. DOCKERY et al
Examiner	**Group Art Unit**
F.J. BARTUSKA	3652

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on APRIL 6, 2000.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1, 4, 10, 17 AND 18-28 is/are pending in the application.

Of the above claim(s) 18-25 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 4, 10, 17 AND 26-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restriction

1. Newly submitted claims 18-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

I. Original claims 1,4,10 and 17 are, drawn to a method of promoting sales in a store, classified in class 186, subclass 52.

II. Newly presented claims 18-25 are, drawn to a magazine, classified in class 281, subclass 15.1+.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the magazine can be used for entertainment or education separate from sales promotions in a store.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original

presentation for prosecution on the merits. Accordingly, claims 18-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 26 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by the "Retailing" publication. The "Retailing" publication discloses soliciting from vendor cites products to be promoted on page 19 in col. 2, lines 42-45; preparing articles for inclusion in a magazine on page 20 in col. 1, lines 28-40 and displaying the magazine next to the check-out counter on page 19 in col. 1, lines 46-49.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication. Tai discloses delivery of coupons in magazines and newspapers in col. 1, lines 26-49; magazines and newspapers include non-product information attractive to customers. The coupons in Tai are directed to brand name products, see col.1, line 32. Tai does not disclose displaying the magazines or newspapers in the store. The "Retailing" publication

discloses displaying magazines next to the check-out counter in lines 46-49 of the first column of page 19. It would have been obvious to one of ordinary skill in the art to display the magazines and coupons of Tai in a store in view of the showing and teaching of the "Retailing" publication.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above. Further, merely calling for the store colors to be on the coupons would involve only a notorious expedient of the art especially in the situation in which the coupon is for a brand which is exclusive to a store.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above. Further, it would have been obvious to one of ordinary skill in the art in view of the teaching on page 20 in lines 28-40 of the first column of the "Retailing" publication to include recipes in magazine advertisements of food, which advertisements include the coupons of Tai.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above, and further in view of Degasperi et al. Tai, as modified by the "Retailing" publication, shows all the features of the applicant's claimed invention except locating the products

near the publication. Degasperi et al teach that coupons are used most often when placed near the products. It would have been obvious to one of ordinary skill in the art in view of the teaching in Degasperi et al to locate the products near the magazines with coupons of Tai.

10. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the "Retailing" publication. The "Retailing" publication discloses all the features of the applicants' claimed invention except the mention of brand names. Merely calling for the magazine articles to include brand names would involve a notorious expedient to one of ordinary skill in the art. For instance product reviews are common in magazines and would be useless if they did not include brand names.

Response to Arguments

11. The applicants' argument that Tai does not suggest the collection of specific information about the products has been considered but has not been found persuasive because the coupons in Tai contain specific information about the products, which information would have had to be collected to be included on the coupons.

Conclusion

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. Bartuska whose telephone number is (703) 308-1111.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

F. J. BARTUSKA
PRIMARY EXAMINER

6/2/00